

REMARKS/ARGUMENTS

Claims 1-13 are pending in the present application. No Claims were canceled; claims 1 and 2 were amended; and claims 45-48 were added. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 103, Obviousness (Claims 1-3 and 6-7)

The Examiner has rejected claims 1-3 and 6-7 under 35 U.S.C. § 103 as being unpatentable over Rourke et al., U.S. Patent No. 5,995,721 (hereinafter “Rourke”) in view of Christodoulou et al., U.S. Publication No. 2002/0159092 (hereinafter “Christodoulou”), Chang et al., U.S. Patent No. 7,318,086 (hereinafter “Chang”) and Messner et al., U.S. Publication No. 2001/0043364 (hereinafter “Messner”). This rejection is respectfully traversed. Office Action dated October 29, 2008, pp. 6-15.

Therefore, the rejection of claims 1-3 and 6-7 under 35 U.S.C. § 103 has been overcome.

A. The examiner bears the burden of establishing a *prima facie* case of obviousness.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The Examiner has failed to meet this burden in the present case. More specifically, the Examiner has failed to ... [For example features are not taught as the Examiner believes, the modifications and combinations would not be made when the references are considered as a whole, the cited reference teaches away from the claims, and not teaching, suggestion, or motivation is present.] These reasons are discussed in more detail below.

In *Graham v. John Deere Co. of Kansas City*, 383 U. S. 1 (1966), the Supreme Court set out a framework for applying the statutory language of §103. The Court stated:

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs,

failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

Id., at 17.18.

In other words, these factual inquiries include (1) determining the scope and content of a patent claim and the prior art relative to a claim in the application at issue; (2) determine the differences between the scope and content of the patent claim and the prior art as determined in (1); (3) determine the level of ordinary skill in the pertinent art; and (4) evaluate any objective indicia of non-obviousness.

B. All claim limitations must be considered, especially when missing from prior art.

1. Claims 1, 45, and 47

Claim 1 has been amended. Support for the amendment is found in the specification, page 5, lines 19-22. Claims 45 and 47 have the same limitations to be discussed below and, therefore, the arguments made in regard to claim 1 apply to claims 45 and 47 as well.

In comparing the cited art to the claimed invention, the claim limitations of the presently claimed invention may not be ignored in an obviousness determination.

The present invention in claim 1 recites:

A computer-implemented method for printing a document comprising:

using a computer, performing the following steps:

reading and analyzing only a plurality of data hidden in each of a plurality of document pages to be printed, each of the plurality of data describing a printable data for a document, to determine a required printer type, wherein the required printer type comprises a specific printer, a color printer, and a black/white printer;

responsive to only determining the required printer type, separating each of the plurality of document pages into a plurality of print jobs based on the required printer type for each document page, wherein all of the print jobs based on the specific printer are first allocated together, then all unallocated print jobs based on the color printer are separately allocated together, and then all remaining unallocated print jobs are allocated together and based on the black/white printer;

placing each of the plurality of document pages into an appropriate holding queue for an appropriate printer for each of the allocated print jobs;

selecting the appropriate printer for each of the plurality of print jobs; wherein the appropriate printer is determined using a print farm profile; and wherein the print farm profile includes data regarding a number, a size, and a type for each of a plurality of print jobs in a print queue for the appropriate printer, and

a printer speed and an amount of paper in a printer bin for the appropriate printer;
and
printing the plurality of print jobs on a plurality of appropriate printers.

All of the features believed to be taught by the cited reference are not present as believed by the Examiner. In particular, does not teach or suggest “reading and analyzing only a plurality of data hidden in each of a plurality of document pages to be printed, each of the plurality of data describing a printable data for a document, to determine a required printer type” and responsive only to determining the required printer type, separating the document pages. In claims 1, 45, and 47 this is accomplished without a job ticket being sent to the printers. Christodoulou explicitly uses a job ticket.

The Examiner points to the following section of Christodoulou as follows:

Alternatively, using data provided in the job request (this may be either implicitly provided in the source data, or explicitly provided as a form of metadata in the job request)....

Christodoulou ([0036], lines 9-16)

When all of Christodoulou’s paragraph [0036] is read, it is seen that the data referred to (1) may come from source data, and (2) is used to send a job request to the printers. Thus, this teaching of Christodoulou does not disclose the claimed invention because the permissive “may” implies a possibility or a probability and this is not sufficient to establish inherency.

To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’

In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999)

Moreover, the use of the data is for dispatching a “job ticket to each of candidate network printer thus identified.” Thus, in Christodolou, pages are dispatched to printers only according to a job ticket, while in the claimed invention the separation of the document pages is accomplished without the need for a job ticket. Therefore, the cited art, individually or in combination, does not disclose the cooperation of the elements detailed in claims 1, 45, and 47.

2. Claim 2

The Examiner states that Rourke '721 teaches reassembling the document to produce a finished document citing column 2, lines 25-28. Rourke, column 2, lines 25-28 states:

Preferably, color prints, corresponding with the color part of the job is delivered to a sheet inserter so that the color prints can be inserted into a stream of black/white prints corresponding with the black/white part of the job.

The cited portion of Rourke does not disclose assembling a document as set forth in claims 1, 45, and 47, but only an insertion of color prints into a stream of black and white prints.

C. An explicit analysis must be provided in an obviousness rejection

In combining references, an explicit analysis is required to combine or modify references. The Supreme Court has stated the following:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006). [R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness .). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int'l v. Teleflex Inc. 500 U.S. 127, 1727, 1741 (2007). Conclusory statements are insufficient to support obviousness rejections. In particular, "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006).

The Examiner stated the following in combining the cited references:

In combining Christodoulou and Rourke, the Examiner stated that it would have been obvious to combine the references in order to “distribute the workflow of the document into different jobs, thus having less amount of work in each device and lowering the extra work of each device making the system more efficient.” (page 10, Final Office Action).

In combining Christodoulou, Rourke and Chang, the Examiner stated that it would have been obvious to include Chang’s print farm profile including a printer speed because “an object may refer to a software and data entity, which may reside in different hardware environments or platforms or applications.” The Examiner further stated that “[a]n object may encapsulate within itself both data and attributes describing the object, as well as instructions for operating that data” and “[f]or simplicity of discussion, an object may also include, for example, the concept of software components that may have varying granularity and can consist of one class, a composite of classes, or an entire application.” (citing Chang, column 5, lines 11-20).

In combining Messner with Christodoulou, Rourke and Chang, the Examiner stated that it would be obvious to make the combination because “it will add more valuable information to the system to make more accurate determinations at the time of choosing the appropriate printer for printing.”

As can be seen, in each of the foregoing cases, an express analysis has not been provided in the Examiner’s reasons for combining the references. The statements made by the Examiner do not provide reasons as required in the Supreme Court guidance on combining references in the KSR case. Instead, the Examiner has only provided statements that are conclusory or reciting some desired goal. These conclusions and desired goals have not been supported with any explicit analysis or articulated technical reasoning with some rationale underpinnings to support the conclusions or goals for combining the elements in these two references in the manner proposed by the Examiner. Further, even if these conclusory statements or goals could be considered “reasons”, they do not have any articulated reasoning with some rational underpinning to support the Examiners assertion of obviousness.

The Examiner has merely offered the following goals or desires:

- distribute the workflow of the document into different jobs, thus having less amount of work in each device and lowering the extra work of each device making the system more efficient;
- an object may refer to a software and data entity, which may reside in different hardware environments or platforms or applications; or
- add more valuable information to the system to make more accurate determinations at the time of choosing the appropriate printer for printing.

To meet these goals, the Examiner states it would have been obvious to combine the cited references. Nowhere, however, has the Examiner gone beyond this conclusion or desired goal to explain in sufficiently why one of ordinary skill in the art would have combined these two references.

II. 35 U.S.C. § 103, Obviousness (Claim 4)

The Examiner has rejected claim 4 under 35 U.S.C. § 103 as being unpatentable over Christodoulou, Rourke, Chang and Messner, and further in view of Sasso, U.S. Patent No. 4,591,146 (hereinafter “Sasso”). This rejection is respectfully traversed. Office Action dated October 29, 2008, p. 15.

Claim 4 depends from claim 1 which is allowable for the reasons set forth above. Therefore, the rejection of claim 4 under 35 U.S.C. § 103 has been overcome.

III. 35 U.S.C. § 103, Obviousness (Claim 5)

The Examiner has rejected claim 5 under 35 U.S.C. § 103 as being unpatentable over Christodoulou, Rourke, Chang and Messner, and further in view of Burns et al., U.S. Patent No. 6,707,950 (hereinafter “Burns”). This rejection is respectfully traversed. Office Action dated October 29, 2008, pp. 15-16.

Claim 5 depends from claim 1 which is allowable for the reasons set forth above. Therefore, the rejection of claim 5 under 35 U.S.C. § 103 has been overcome.

IV. 35 U.S.C. § 103, Obviousness (Claim 8)

The Examiner has rejected claim 8 under 35 U.S.C. § 103 as being unpatentable over Christodoulou, Rourke, Chang and Messner, and further in view of Winston et al., U.S. Publication No. 2002/0186384 (hereinafter “Winston”). This rejection is respectfully traversed. Office Action dated October 29, 2008, pp. 16-17.

Claim 8 depends from claim 1 which is allowable for the reasons set forth above. Therefore, the rejection of claim 8 under 35 U.S.C. § 103 has been overcome.

V. 35 U.S.C. § 103, Obviousness (Claims 9-12)

The Examiner has rejected claims 9-12 under 35 U.S.C. § 103 as being unpatentable over Christodoulou, Rourke, Chang and Messner, and further in view of Lobiondo, U.S. Patent No. 5,287,194 (hereinafter “Lobiondo”). This rejection is respectfully traversed. Office Action dated October 29, 2008, pp. 17-20.

Claims 9-12 depend from claim 1 which is allowable for the reasons set forth above. Therefore, the rejection of claims 9-12 under 35 U.S.C. § 103 has been overcome.

VI. 35 U.S.C. § 103, Obviousness (Claim 13)

The Examiner has rejected claim 13 under 35 U.S.C. § 103 as being unpatentable over Christodoulou, Rourke, Chang and Messner, and further in view of Ferlitsch et al., U.S. Publication No. 2004/0190042 (hereinafter “Ferlitsch”). This rejection is respectfully traversed. Office Action dated October 29, 2008, pp. 20-21.

Claim 13 depends from claim 1 which is allowable for the reasons set forth above. Therefore, the rejection of claim 13 under 35 U.S.C. § 103 has been overcome.

VII. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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